

REMARKS

Claims 1 – 20 remain in the application and stand finally rejected. A proposed amendment to claims 1, 3, 6, 8, 11, 13 and 18 is offered herein. This Amendment is being filed with a one (1) month and extension of time; and, therefore, the Commissioner is hereby authorized to charge the appropriate fee for the extension and any other fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 1 – 20 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,584,185 to Nixon in view of U.S. Patent No. 6,252,953 to Gruchala et al. Essentially repeating the rationale of the prior Office action, it is asserted that Nixon teaches the present invention, i.e., “the claimed desk sharing application (reads on hoteling of Nixon; see column 4, lines 41 – 63 and column 15, line 62 – column 16, line 22).” Page 3. It is also asserted that Nixon Figures 2 and 3 show an Enterprise Communication Platform and that the claimed administrative library is equivalent to the Nixon User directory 80. Also, it is again asserted that Nixon col. 9, line 48 – col. 15, line 61, teaches the configuration of claims 9 and 19 and the API of claims 10 and 20. It is, however, acknowledged that Nixon does not teach “reserving an available shared telephone device.” Thus, Gruchala et al. is cited to show such a shared telephone device in a desk sharing environment at col. 1, lines 15 – 23.

As previously noted, Nixon teaches a telephony system wherein, “a **user** may be able to log in to the telephony system, **identify** himself to his phone, **and have** the telephone configure itself to the individual’s preprogrammed and personalized configuration.” Col. 4, lines 52 – 55 (emphasis added). Thus, Nixon teaches the user manually identifying him/herself and manually initiating reconfiguration. Nixon discusses “a ‘hotelings’ environment, such as a field sales office or call center, in which **individuals use any available office** on a given day and are not permanently assigned to a physical work location.” Col. 4, lines 59 – 63. (emphasis added) Nixon touts this hotelings capability (ad hoc sharing of a number of unassigned offices or cubicles, *physically*, by a larger number of users) as an advantage provided by the Nixon system.

Col. 15, line 62 – col. 16, line 22. Since telephones in vacant offices are available, an on-site user simply selects and occupies a vacant office, which selects the telephone and any other devices in the office. The on-site user can see in real time which telephones/devices are in vacant offices and so, are available. Thus, it is no wonder that Nixon fails to teach “reserving an available shared telephone device.” There is no need to. Further, reserving an on-site location to an off-site user would frustrate the hoteling purpose of the Nixon system. On-site users would no longer be able to tell what resources were available in vacant offices. What good is a cubicle to a sales person, when the telephone/computer/other resources are tied up by someone off-site? No sales calls will be made from that cubicle, at least as long as the resources are unavailable.

As also previously noted, Gruchala et al. teaches a “work-at-home telecommunication service” that responds “to receiving, from a calling party, a service-specific vertical feature code and a dialed number to initiate a call.” Abstract, lines 1 – 3. Thus, someone using the Gruchala et al. invention is clearly not on-site and not using a cubicle. Furthermore, as was also previously noted, Gruchala et al. is concerned with allowing a corporation to “reduce office space requirements, ..., by sharing desk space among a number of telecommuting employees. If needed, a desk at the office can be reserved for a limited duration, ... (when), the telecommuting employee can perform certain tasks which are most amenable with he/she being at the office.” Col. 1, lines 15 – 23. Clearly, if not at odds with Nixon, there is at least no suggestion to combine from either Gruchala et al. or Nixon.

In responding to arguments in the applicants’ previous response, the final office action implies that there is no requirement for a suggestion to combine asserting that, “the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art. See *In Re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).” As the basis for the suggestion, however, it is asserted that, “**both** references plainly teach the desk sharing environment... .” (emphasis the Examiner’s). However, physically sharing a desk as described in Nixon is quite different than a desk sharing application for off-site users as described in Gruchala et al.

“To support the conclusion that the claimed invention is directed to obvious subject matter, either **the references** must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the **teachings of the references.**” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). An obviousness rejection cannot be based on the resort to the combination of bits and pieces of the references in the light of applicants’ teachings. An extensive discussion of the criteria to be applied in obviousness rulings is set forth in *Aqua-Aerobic Systems Inc. v. Richards of Rockford Inc.*, 1 U.S.P.Q. 2d 1945, 1955-57 (N.D. Ill. 1986). “The mere fact that the prior art could be so modified would not have made the modification obvious **unless the prior art suggested the desirability of the modification.**” *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (emphasis added). *See also, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device “may be capable of being modified to run the way [the] apparatus is claimed, there must be a suggestion or motivation **in the reference** to do so.” 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added)). The applicants believe that, for the reasons set forth above, the combination of Nixon and Gruchala et al. is unwarranted by the disclosures of those references or any reference of record and, therefore, improper. Therefore, the combination of Nixon and Gruchala et al. is not suggested and does not result in the present invention as recited in claims 1 and 11, as filed or as amended.

In further responding, regarding the prior assertion that, as recited in claims 1 and 11, it is the desk sharing application, not the user, “**automatically** impersonating full user identity and feature functionality from said dedicated telephone device to said shared telephone device” (emphasis added); the final Office action asserts that the claims “never ever recite that it is the desk sharing application itself that is automatically impersonating full user identity and feature functionality from said dedicated telephone device to said shared telephone device.” However, a user logging “in to the telephony system, [identifying] himself to his phone,” (Nixon, col. 4, lines 52-53) would not be considered “automatically impersonating full user identity and feature functionality” as claims 1 and 11 both recite. While the applicants believe that the recitation of “**automatically** impersonating full user identity” sufficiently supports the above asserted difference, rather than belabor this point, claim 1 is amended by the above proposed amendment

to affirmatively recite that it is “said desk sharing application [that is] automatically impersonating full user identity” and, therefore, the proposed amended claims do indeed “recite that it is the desk sharing application itself that is automatically impersonating full user identity and feature functionality from said dedicated telephone device to said shared telephone device.” The amendment to claim 1 is supported by the specification as filed.

Furthermore, claim 3 is amended to recite “said desk sharing application determining availability of the reserved said shared telephone device and reserving at least one other shared resource.” No reference of record shows a desk sharing application determining resource availability. Claim 11 is amended to recite “means for receiving reservations for available shared telephone devices; means for automatically verifying availability for received said reservations; means for automatically assigning shared telephone devices responsive to verification of availability;” No reference of record shows *automatically* verifying availability and *automatically* assigning available shared telephones. Claim 13 is amended to recite “means for automatically reporting desk sharing status upon assigning shared resources and marked said shared resources unavailable.” No reference of record shows *automatically* reporting desk sharing status and marking shared resources unavailable. This proposed amendment to claims 3, 11 and 13 is supported in the present application on page 7, lines 1 – 25 with reference to Figure 2. The proposed amendment to claims 6, 8, and 18 is in accord with the amendment to the independent claims from which those claims depend.

Since dependent claims include all of the differences with the prior art as the claims from which they depend, dependent claims 2 – 10 and 12 – 20, which depend from claims 1 and 11, are not made obvious by the combination of Nixon and Gruchala et al. Entry of the amendment, reconsideration and withdrawal of the final rejection of claims 1 – 20 under 35 U.S.C. §103(a) is respectfully requested.

Claims 1 – 20 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of co-pending US Patent Application No. 10/610,451. (See Office action, page 4.) While the applicants do not necessarily agree with the characterization provided by the Office action of the claims allegedly

in conflict; because this rejection is provisional and since none of the claims identified as being in conflict have yet been patented, response is premature and the applicants defer addressing the provisional rejection. However, the applicants reserve the right to address such rejection when appropriate.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 – 20 under 35 U.S.C. §103(a) and allow the application to issue.

The applicants note that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.
(emphasis added.)

The applicants believe that the written description of the present application is quite different than and not suggest by any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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